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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/717,532      | 11/20/2003  | Shannon Jaeger       |                     | 7986             |

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EXAMINER

GREEN, CHRISTY MARIE

ART UNIT PAPER NUMBER

3635

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/717,532

**Applicant(s)**

JAEGER, SHANNON

**Examiner**

Christy M Green

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a second office action for serial number 10/717/532, entitled Tile, filed on November 20, 2003.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: it appears that in claim 1, lines 41 and 45 there are mis-spellings of the word, "if". It appears as if these words should be "of". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, US Patent # 880,098, in view of Morrison et al, US Patent # 4,307,554.

Robinson discloses the claimed invention an element comprising eight wooden elements (figure 1) that have top and bottom surfaces, each of the elements also include a concealed flap, first and second portions, a middle portion, and an exposed flap, wherein the concealed flap is adjacent the first raised portion, the exposed flap is adjacent the second raised portion and the middle is between the first and second raised portion such that the concealed flap, the middle portion, and the exposed flap are positioned in substantially the same plane. The flaps and portions of the eight wooden elements are positioned as stated in the claim (as seen in figure 1). Robinson further

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discloses that the element is capable of receiving nails and inserting tabs and raised portions of an adjacent tile, since the element is made of wood it is capable of receiving a nail.

Robinson teaches an element as stated above, but does not specify that the wood is plywood or that tabs/raised portions are inserted into an adjacent tile. Morrison shows that it is known in the art that strips of plywood are bendable (column 10, lines 33-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize plywood as a material when forming a wooden strip, since this material is known to have the ability to be bent or curved. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an adjacent tile with tabs and raised portions inserted within an adjacent tile in order to conceal the ends of the tile which would allow for a smooth appearance of a number of elements combined to form a decorative wall façade.

### ***Response to Arguments***

Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive.

In response the applicants arguments that the '098 patent doesn't teach or suggest a plurality of tiles for covering a surface such that at least two exposed flaps of each tile are for receiving nails for fixedly attaching to the surface and where at least two exposed flaps of each tile are for slidably inserting into the first and second raised portions on a next tile, such that the nail in the exposed flaps are covered and the plurality of tiles creates a seamless continuous appearance, the examiner recognizes

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the argument. Applicant's phrase, "wherein a plurality...continuous appearance" (page 3, lines 12-16) comprises a recitation of intended use of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987). Therefore, if the prior art is capable of performing the intended use, it meets the claim. In this case, Robinson's exposed flaps are capable of being inserted under raised portions of an adjacent tile.

Furthermore, applicant should note that a claimed with a preamble citing "A tile" is considered as being drawn to a single tile alone. However, if Applicant intended to claim a plurality of tiles, the language of the preamble should be changed to indicate a plurality of tiles.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy M Green whose telephone number is 571-272-6844. The examiner can normally be reached on M,T,TH 10:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cg  
May 23, 2005



Carl D. Friedman  
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Group 3600